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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,478	01/07/2002	Niko Eiden	017.40791X00	*9205

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EXAMINER

ORTIZ, ANGELA Y

ART UNIT	PAPER NUMBER
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1732

DATE MAILED: 09/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/036,478

Applicant(s)

EIDEN, NIKO

Examiner

Angela Ortiz

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-- The MAILING DATE of this communication appears n th cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 26-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-25 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

Election/Restrictions

Applicant's election of claims 1-25 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 26-47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The title should reflect the elected method; please insert –METHOD OF MAKING—before “ILLUMINATED COVERS”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 4-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cass et al., USP 5,780,965 in view of EP 0 932 288 A1.

The cited primary reference teaches the basic claimed process of forming a device cover including a composite or laminate foil having multiple layers, further including an electroluminescent. The detailed method steps include providing an electroluminescent display having a transparent layer (16), also at least one translucent layer (18), and an electroluminescent planar layer (22). The transparent layer (16) may be preformed and provided with at least one aperture (17c). The translucent layer is provided with window sections and may include graphics or decorative printings. Note also that the plastic materials used to form the transparent and translucent layers are well known in the molding art to possess electrically insulative features. The composite or laminate is in sheet form and may be further shaped into a three-dimensional configuration using conventional shaping or molding means. When shaped, it is placed within a cavity of an injection mold, and a resin forming substrate is provided in contact

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with the shaped sheet to form an integrally attached substrate. See col. 3, lines 30-50, 59-62; col. 4, lines 5-18, 30-55, and col. 5, lines 5-25.

The cited primary reference does not teach providing a mold with bosses corresponding to the openings provided in the composite or laminate foil.

The cited secondary reference teaches as conventional the molding of a device cover using a pre-shaped composite foil having openings therein, wherein the openings are used to position pins therein prior to molding of the substrate, to prevent resin from closing the openings. The detailed method steps include providing a composite foil-decorating film having multiple layers. The composite foil-film is brought into contact with a molding surface and shaped within the molding cavity. The mold is provided with slide cores that are pushed through the film into the mold cavity into contact with the upper mold half, wherein the step of pushing punches holes within the film. Resin is molded into the mold cavity in integral contact with the composite foil-film. During molding, the slide cores stay in contact with the mold have and serve as mold bosses to keep the openings open until the resin is cured. Please see page 8, paragraphs 0054-0058.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a mold with bosses corresponding to the openings within the composite film, in view of the added reference, for keeping the openings open until the resin, being molded in integral contact with the composite film, is cured.

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With respect to claims 2, 4-5, 7, 9, 11, 15-17, 19, 21, 23, see USP 5,780,965 wherein multiple layers and combinations of layers are taught as conventional, having graphics, openings or both, see col. 3, lines 30-65 and col. 5, lines 1-25.

With respect to claims 6, 8, 10, 12, 18, 20, 22, and 24, thermally insulative foil is disclosed as polycarbonate in the instant specification (see layer 32), which is taught as conventional alternative material or film layer in the secondary reference at paragraphs 0025, 0034.

With respect to claims 13 and 25, see EP 932 288 at paragraphs 0055, 0056.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-25 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-33 of copending Application No. 09/940,624. Although the conflicting claims are not identical, they are not patentably distinct from each other because both, in claim one of this

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application and claim 1 of the copending application, set forth the method of making a device cover wherein the cover includes an insulating layer foil positioned or attached to a first surface of an electroluminescent foil with that together form a preliminary cover, wherein the cover is provided with holes therein, pre-shaping the cover (foils) and placing the shaped cover within an injection mold cavity such that bosses in the cavity fit within the holes or openings of the cover, and forming a substrate integrally with the shaped foils.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Allowable Subject Matter

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USP's 3989775; 4205036; 4406045; 5227222; 5512226; and 5567362.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angela Ortiz whose telephone number is 703-308-4446. The examiner can normally be reached on Monday-Thursday 9:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703-305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


Angela Ortiz
Primary Examiner
Art Unit 1732

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